REMARKS/ARGUMENTS

Claims 1-5 and claims 20-22 remain in this application. Claims 27 and 28 have been newly added. Of these claims, claims 4, 5, and 20 to 22 have been previously allowed. Entry of the foregoing and favorable reconsideration and examination of the subject application, as amended, pursuant to and consistent with 37 C.F.R. § 1.116, and in light of the following remarks is respectfully requested.

Applicants respectfully submit that the current amendments are solely of a clarifying nature, and do not constitute narrowing amendments. Claims 23-26 have been cancelled without prejudice or disclaimer to expedite allowance of the current application and not to acquiesce to the Examiner's rejections. Applicants reserve their rights to pursue the subject matter of the cancelled claims in a continuation application or divisional application.

Claim 1 has been amended to mirror the language used to allowed claim 21. New claims 28 and 29 are dependent upon claim 1 and 21 and are drawn to transgenic cotton plants, which are progeny of the cotton plants of either claim 1 and 21. Support for the amendment may be found throughout the specification, at least in paragraph [0059]. No new matter has been added by these amendments.

Claim Rejections 35 USC § 112

Claims 1 to 3 and 23 to 26 remain rejected under 35 U.S.C. § 112, first paragraph, for the reason of record as set forth in the Office Action mailed May 7, 2003.

In making this rejection, the Examiner purports that given the little guidance provided by the Applicants, the nature of the invention and the unpredictability of the art in producing elite events in plants, it would have required undue trial and error experimentation by one of skill in the

art at the time of Applicants' invention to reproduce elite event EE-GH1 in another cotton plant, without resorting to the cotton plant deposited at the ATTC. According to the Examiner, it is particularly pertinent that the prior art teaches that it is difficult to target transgenes to specific loci in the chromosomes of a plant and thereby create a heteroallelic recombination target, and that such methods cannot be applied to flowing plants such as cotton in the instant case.

Claims 23 to 26 have been cancelled. Claim 1 has been amended to incorporate that reference seed comprising the elite event EE-GH1 have been deposited at the ATCC under accession number PTA-3343, as in allowed claim 21. In as far as the objection still applies to the amended claims, Applicants respectfully traverse.

Applicants reiterate that claims 1 to 3 are claims drawn towards a composition of matter, namely transgenic cotton plants, seed, cells or tissues comprising elite event EE-GH1 as it can be found, e.g., in the reference seed deposited at the ATCC under accession number PTA-3343.

The reference seed has been deposited at the ATCC for the purpose of fulfilling the enablement requirement of 35 U.S.C. § 112, first paragraph. As indicated at least on page 19, last paragraph, the "elite event EE-GH1" can be introduced into any and all cotton plants or cultivars by classical breeding techniques, such as recurrent backcrossing. To achieve this goal, the person skilled in the art may at least use the seeds, deposited for that purpose. Thus, a person skilled in the art can make all the compositions covered by claims 1 to 3 by at least one method, without undue experimentation.

The Examiner does not disagree with Applicants' argument that the application teaches at least one method for obtaining the claimed composition of matter over the entire scope of the claims 1 to 3, but rather argues that the "argument is not persuasive because the instant claims are not directed to a product by process wherein said product is produced from the deposited line PTA-3342, but reads on reproducing the elite event EE-GH1, which the Examiner maintains is

unpredictable and would have required undue trial and error experimentation by one of skill in the art at the time of Applicant's invention without the PTA-3343 deposit line".

In other words, the Examiner apparently agrees that the claimed cotton plants, seeds, cells and tissue can be made in one way, as disclosed in the specification, but rejects the same subject matter as non-enabled because allegedly it can not be made in another way. This is legally incorrect.

Indeed, **"the law makes clear that the specification need teach only one mode of making and using a claimed composition."** Amgen v. Hoechst Marion Roussell, at 160, 57 USPQ2d at 1515 (citing Johns Hopkins Univ. v. Cellpro, Inc., 152 F.3d 1342, 1361, 47 USPQ2d 1705, 1719 (Fed. Cir. 1998); Engel Indus. Inc. v. Lockformer Co., 946 F.2d 1528, 1533, 20 USPQ2d 1300, 1304 (Fed. Cir. 1991)); see also Durel Corp. v. Osram Sylvania Inc., 256 F.3d 1298, 1308, 59 USPQ2d 1238, 1244 (Fed. Cir. 2001). **"Non-enablement is the failure to disclose <u>any</u> mode".** <u>Spectra-Physics, Inc. v. Coherent, Inc.</u>, 3 USPQ2d 1737, 1744 (Fed. Cir. 1987).

This situation is akin to composition of matter claims in chemistry. There it is established practice that a novel, inventive and useful chemical whose synthesis is fully enabled by a disclosed production method will entitle an applicant to the absolute protection of a composition of matter claim. The fact that alternative synthesis methods may become available after the time of filing the application will not give rise to a rejection of the composition as non-enabled, nor will it elicit a requirement to limit the claim to a product-by-process claim. Neither should the possibility that alternative production methods to obtain the currently claimed cotton plants of claims 1 to 3 may become available in the future give rise to a rejection of these claims as non-enabled.

Finally, Applicants would like to draw the Examiner's attention to the fact that allowed claims 21 and 22 are also not limited to plants or seed made by crossing with the deposited seeds, and arguably also cover cotton plants or seed comprising elite event EE-GH1 obtained by any alternative production method.

In view of the above amendments and remarks, withdrawal of the rejection is respectfully requested.

From the foregoing, reasonable action in the form of a Notice of Allowance is respectfully requested and earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 50-0206 for any additional fee required under 37 C.F.R. § § 1.16 or 1.17; particularly extension of time fees.

Respectfully submitted,

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By: _____
Robert M. Schulman
Registration No. 31,196

David H. Milligan
Registration No. 42,893

HUNTON & WILLIAMS LLP
Intellectual Property Department
1900 K Street, N.W.
Suite 1200
Washington, D.C. 20006-1109
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)

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